

## **REMARKS**

This application has been carefully reviewed in view of the Office Action mailed April 7, 2009. All rejections are respectfully traversed and reconsideration is respectfully requested.

### **Regarding the Information Disclosure Statements**

Applicant appreciates the Examiner's consideration of the Information Disclosure Statements. It is noted that several references are presented, but were not considered due to failure to cite page numbers. These references are of general interest, but are no more relevant than those already considered.

Applicant also regrets the duplicate IDS submissions. Due to the large family of applications associated herewith, the record keeping burden to attempt to keep the references from being submitted multiple times is substantial. A database is maintained of these references and an IDS is periodically sent out in all related cases, but sent out immediately in the application with the foreign counterpart in which an office action is received. As a result, sometimes duplicates result in a case that has a foreign counterpart that produced a reference found in the IDS. Applicant regrets the inconvenience this may have caused the Office and will endeavor to minimize this in the future.

### **Regarding the Rejection Under 35 U.S.C. § 103(a)**

All claims were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Unger and Colligan, or Unger, Colligan and Sezer of record. Patent 5,905,732 is also used to support the rejections. These rejections are again respectfully traversed.

For the Patent Office to combine references in an obviousness rejection, the Patent Office must first establish *prima facie* obviousness by showing where each and every element is taught or suggested in the combined references. MPEP § 2143.03. This is fundamental to an analysis under the factual inquiries required by *Graham v. John Deere*, 383 U. S. 1 (Supreme Court, 1966) as a part of identification of the scope and content of the prior art. Additionally, the claimed elements must be arranged as claimed. The Patent Office has failed to do so in the present rejection. Multiple claim elements are missing from the combination of Unger and Colligan, and

the Patent Office has failed to provide any articulated reasoning as to why one of ordinary skill in the art would find the claims as a whole to be obvious in the absence of the claim features not present in the cited art (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), as explicitly endorsed by the Supreme Court). Such an analysis is required in order to satisfy the factual inquiry ascertaining the differences between the prior art and the claims at issue. Accordingly, the Patent Office has failed to establish *prima facie* obviousness and the present rejection should be withdrawn.

As an initial matter, Applicants hereby reiterate the arguments presented in the prior responses and stand by those remarks. Reconsideration of those arguments in the context of the present response is respectfully requested. However, in order to expedite prosecution of the present application, several clarifying amendments have been made to the independent claims.

Regarding the rejection of all independent claims, Applicant has amended the independent claims to clarify that all elements of the process are carried out at a service provider site. It is noted that the Office argues at page 5, lines 12 that the requester would strip out the encrypted contents and references Unger paragraph [0065]. However, the claim language now even more explicitly calls for all process elements to be carried out at the service provider site, whereas Unger strips out unused packets at the receiver. Applicant does so at the transmitter (service provider site) and thereby conserves network bandwidth.

Per MPEP 2341.01 V the proposed modification cannot render the prior art unsatisfactory for its intended purpose. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”. In Unger, although the unused encrypted portion is stripped out, it is done so at the receiver – not at a VOD service provider. In Unger, if either one of the first or second encrypted portions of the content are stripped out at the service provider, the main function of Unger is destroyed. Unger’s method permits simultaneous use of both legacy and new encryption systems in the same network. If one set of duplicate packets is stripped out, as proposed in the modification to Unger, then either a legacy or new encryption device will fail to decrypt the content properly. It is further noted that in a VOD system consistent with Unger, there is no necessity in stripping out

the unused encrypted portion from the content at the service provider. However, in the case of the present claims, by recognizing that the VOD order came from either a receiver capable of only either the first or second decryption, the incompatible encryption can be stripped out to conserve bandwidth on the network.

Hence, the interpretation of stripping out the encrypted content at the receiver has been precluded from the present claims, and modification of Unger to achieve this is established to destroy the intended function of Unger. Accordingly, Unger is misapplied and the combination of Unger and Colligan (together or in combination with the other references) fails to meet all claim features. Reconsideration and allowance are respectfully requested.

It is further noted that the Office's position is that the storage requirements of the claim are met by "inherently" requiring that the content and duplicate copies are stored "at least temporarily" during content processing. Applicant disagrees and notes that inference requires proof that the process necessarily could not have been carried out any other way. However, in the interest of expediting prosecution, the claims have further been amended in an attempt to clearly call out that the storage is more permanent and is done to await an order for the content. The claim language is intended to mean such, but if the Examiner feels that further qualification is in order, Applicant is happy to oblige and respectfully requests the courtesy of a telephone call to work our suitable language.

As has been previously noted, Applicant further finds no teaching or suggestion of stripping out the encrypted content having the identifiable duplicate selected packets in response to a request for the content from a device that uses the second encryption system. Accordingly, the Patent Office has not shown where each and every element of claim 1 is found within the combination of references and the rejection of claim 1 should be withdrawn for at least these reasons.

In view of the above, all independent claims are clearly in condition for allowance and such is respectfully requested.

The prior arguments favoring patentability of the independent and dependent claims are reiterated and in combination with the shortcomings of the cited references in the independent claims clearly refute any allegation that the current claims are *prima facie* obvious. Applicant

respectfully submits that all claims are in condition for allowance and notice of the same is requested at the earliest possible date. Applicant reserves the right to provide additional arguments against the rejection of these claims in the future if needed. In view of the above, reconsideration and allowance are respectfully requested.

**Concluding Remarks**

In view of the discussion above, all claims are clearly in proper condition for allowance. Reconsideration is respectfully requested and notice of allowance for all pending claims is respectfully requested at the earliest possible date.

If any issues remain, the Examiner is again earnestly requested to contact the undersigned for a telephone interview in order to expedite prosecution and avoid the necessity and expense of appeal.

Respectfully submitted,

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